

## **REMARKS / ARGUMENTS**

### **I. General Remarks**

Applicants respectfully request that the above amendments be entered and further request reconsideration of the application in view of the amendments and the remarks contained herein.

### **II. Disposition of the Claims.**

At the time of the Office Action, claims 1-17 were pending. Claims 1-17 stand rejected. Claims 12-14 and 17 have been amended herein, and claims 1-11 have been cancelled in response to a restriction requirement. Applicants respectfully submit that these amendments add no new matter to the application and are supported by the specification as originally filed. All the above amendments are made in a good faith effort to advance the prosecution on the merits of this case.

### **III. Remarks Regarding Information Disclosure Statements**

With respect to the information disclosure statements filed on February 10, 2004, April 25, 2005, June 15, 2005, July 5, 2005, July 12, 2005, August 15, 2005, August 29, 2005, April 24, 2006, and May 30, 2006, the Office Action states:

The information disclosure statements . . . taken cumulatively, fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP §609 because it is concluded that given the nature of the claimed subject matter that the lengthy IDS involves cumulative references . . . The submissions have been placed in the application file, but the information referred to therein has not been considered as to the merits . . .

It is noted that submissions 6) and 10) appear to be identical.

It is noted that the citations of "search reports" do not comply with 37 CFR 1.98 (b)(5) with respect to "publication" date.

It is noted that numerous submissions cited under "non-patent literature" fail to comply with 37 CFR 1.98 (b)(5) with respect to "publication" date. (See MPEP 609.04 (a)(I)(seventh paragraph, third to last sentence: month and year required.)

It is noted that citations of pending US patent applications fail to comply with MPEP 609.04(a)(I) (seventh paragraph, last sentence, section heading requirement).

(Office Action at 2-3.) It is Applicants' position that all references included in the originally filed information disclosure statements may be relevant. Submitted herewith is an information disclosure statement including references only directed towards subterranean applications. Applicants make no representation that those references submitted in previously filed information disclosure statements but not resubmitted herewith are not relevant.

With respect to the publication dates of the non-patent literature cited in this information disclosure statements, the MANUAL OF PATENT EXAMINING PROCEDURE states that "[t]he date of publication supplied must include at least the month and year of publication, except that the year of publication (without the month) will be accepted if the applicant points out in the information disclosure statement that the year of publication is sufficiently earlier than the effective U.S. filing date and any foreign priority date so that the particular month of publication is not in issue." MPEP § 609.04(a)(I). Applicants have stated in the information disclosure statement enclosed herewith that the non-patent references listed only with the publication year were published earlier than the effective U.S. filing date of the present application. Therefore, Applicants respectfully submit that the information disclosure enclosed herewith is in compliance with MPEP 609.04(a)(I) and further request consideration of these references on the merits.

#### **IV. Remarks Regarding Restriction/Election Requirements**

On September 26, 2005 during a telephone conversation with Primary Patent Examiner Zakiya N. Walker, claims 7-17 were provisionally elected without traverse in response to the Examiner's restriction requirement. This provisional election is hereby confirmed, and claims 1-6 have been canceled.

On June 6, 2006 during a telephone conversation with Primary Patent Examiner Matthew A. Thexton, claims 12-17 were provisionally elected without traverse in response to a supplemental restriction requirement. This provisional election is hereby confirmed, and claims 7-11 have been canceled.

#### **V. Remarks Regarding Objections to the Specification**

The disclosure is objected to because "[t]he provisions of 37 CFR 1.52(b)(6) have not be[en] adhered to with respect to several aspects of the paragraph numbering. A substitute specification as provided by 37 CFR 1.121(b)(3) is suggested." (Office Action at 7.)

Applicants submit herewith a substitute specification pursuant to 37 C.F.R. 1.125 in accordance with the Examiner's suggestion. Since Applicants have only changed the paragraph numbering in the specification, Applicants have submitted only a clean version of the specification without markings, as provided by 37 CFR 1.125(c). Applicants further submit that the substitute specification contains no new matter. Accordingly, Applicants respectfully request the removal of this objection.

**VI. Remarks Regarding Rejections Under 35 U.S.C. § 112, second paragraph.**

Claims 12-17 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Specifically, the Office Action states that "[t]he basis upon which to calculate the %'s is not set forth, rendering the claims indefinite and unclear." (Office Action at 8.) Claim 12 has been amended to set forth the basis upon which to calculate the percentages of the components comprising the resin composition. Therefore, Applicants respectfully request withdrawal of this rejection with respect to claims 12-17.

**VII. Rejections of Claims Under 35 U.S.C. § 103(a)**

**A. Rejections Over *Nguyen* '488 In View of *Anderson* or *Murphey* or *McLaughlin***

Claims 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,924,488 issued to Nguyen *et al.* (hereinafter "*Nguyen* '488") in view of U.S. Patent No. 4,042,032 issued to Anderson *et al.* (hereinafter "*Anderson*") or U.S. Patent No. 4,070,865 issued to McLaughlin (hereinafter "*McLaughlin*"), or U.S. Patent No. 5,128,390 issued to Murphey *et al.* (hereinafter "*Murphey*").

With respect to this rejection, the Office Action states:

The reference '488 discloses proppants comprising hardenable resin coated particles, which may be phenol-aldehyde resins (column 5, lines 3-4), in viscosity controlling diluents such as fufuryl alcohol and phenol (column 5, lines 16-19), and resin-to-sand coupling agent such as aminosilanes (column 5, lines 22-33); which hardenable resins are disclosed to be known in the art, such as in references '032, '865, and 390 (column 4, lines 55-65). '488 fails to disclose the use of a surfactant.

'032, '865, and 390 each disclose the use of surfactant in hardenable resin compositions; '032 (column 6, lines 13-30), '865 (column 4, lines 13-28), '390 (column 6, line 66 to column 7, line 57). In view of '488 incorporating these disclosures, it is concluded that it would have been obvious to one of ordinary skill

in the art at the time of the invention to have employed surfactants in the mixtures of '488. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the phenol-aldehyde resins, viscosity controlling diluents such as furfuryl alcohol and phenol, and resin-to-sand coupling agent such as aminosilanes, each as suggested in '488, and thereby arriving at subject matter encompassed by Applicant's claims.

(Office Action at 9-10.) Applicants respectfully disagree with these rejections because *Nguyen* in view of *Anderson* or *McLaughlin* or *Murphey* does not teach or suggest every element of independent claim 12.

To form a basis for a § 103(a) rejection, a prior art reference must teach or suggest each element in the claim in such a way that enables a person of ordinary skill in the art to make or use the claimed invention. MPEP §§ 2141.01(II) & 2142 (2004). However, Applicants respectfully assert that *Nguyen* '488 in view of *Anderson* or *McLaughlin* or *Murphey* does not teach or suggest a resin composition comprising "from about 5% to about 30% phenol by weight of the resin composition; from about 40% to about 70% phenol formaldehyde by weight of the resin composition; from about 10% to about 40% furfuryl alcohol by weight of the resin composition; from about 0.1% to about 3% of a silane coupling agent by weight of the resin composition; and from about 1% to about 15% of a surfactant by weight of the resin composition", as recited in independent claim 12.

Rather than disclosing this recitation, *Nguyen* '488 provides that "diluent which are generally useful with all of the various resins mentioned above include phenols, formaldehydes, furfuryl alcohol, and furfural." *Nguyen* '488, col. 5, lines 19-21. Nowhere does *Nguyen* '488 disclose the relative amounts of the components necessary to achieve the resin compositions of the Present Application. Nor does *Anderson* or *McLaughlin* or *Murphey* provide the missing recitation. Accordingly, *Nguyen* '488 in view of *Anderson* or *McLaughlin* or *Murphey* does not disclose each and every limitation of independent claim 12. Therefore, Applicants respectfully request withdrawal of the 35 U.S.C. § 103(a) rejection as to independent claims 12 and correspondingly as to dependent claims 13-17.

**B. Rejections Over *Nguyen* '976**

Claims 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,013,976 issued to *Nguyen et al.* (hereinafter "*Nguyen* '976") in view of *Anderson*.

Applicants respectfully submit that *Nguyen* '976 is not available as prior art against the present application under § 103(a), pursuant to 35 U.S.C. § 103(c). *Nguyen* '976 can only be available as prior art against the present application under 35 U.S.C. § 102(e), as the issue date of *Nguyen* '976 is March 21, 2006, which is after the filing date of the present application. However, the present application and *Nguyen* '976 were, at the time the invention of present application was made, both owned by Halliburton Energy Services, Inc. As the present application was filed on or after November 29, 1999, a statement of common ownership, at the time the invention of the present application was made, is sufficient to remove prior art from the purview of 35 U.S.C. § 103(a) if that prior art would have been prior art only under 35 U.S.C. § 102(e). M.P.E.P. § 706.02(l). Accordingly, *Nguyen* '976 is no longer available as prior art under 103(a) in accordance with 35 U.S.C. § 103(c). Thus, Applicants respectfully submit that the 35 U.S.C. § 103(a) rejection against claims 12-17 over *Nguyen* '976 is no longer applicable, and this rejection should be withdrawn.

**VIII. No Waiver**

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example distinctions from the cited references. Other distinctions may exist, and Applicants reserve the right to discuss these additional distinctions in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements, such as, for example, any statements relating to what would be obvious to a person of ordinary skill in the art. The example distinctions discussed by Applicants are sufficient to overcome the obviousness rejections.

**SUMMARY**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this

application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

Applicants believe that there are no fees due in association with this filing of this Response. However, should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Halliburton Energy Services, Inc., No. 08-0300.

Respectfully submitted,



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Date: September 12, 2006